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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/112,131	07/08/1998	JAY S. WALKER	96-002-C1	6549
22927	7590	08/25/2005	EXAMINER	
WALKER DIGITAL FIVE HIGH RIDGE PARK STAMFORD, CT 06905			NGUYEN, CUONG H	
			ART UNIT	PAPER NUMBER
			3661	

DATE MAILED: 08/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/112,131	WALKER ET AL.	
	Examiner	Art Unit	
	CUONG H. NGUYEN	3661	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 4/22/05 (the IDS).
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 177-189 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 177-189 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on /08/1998 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>4/22/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Office Action is the answer to the IDS filed on 4/22/2005, which paper has been placed of record.
2. Claims 177-189 are pending in this application.

Response:

3. The Appeal Conferees want the examiner to re-open this case for a better-formatted presentation of rejections ground(s), and evident supports for well-known practices arguments using in previous final rejection so that the Appeal Court would review an organized Examiner's Answer. The examiner withdraws the Restriction Requirement mailed on 6/07/2004 to answer a paper received on 1/17/2005; the arguments on previous grounds of rejections are moot with a better reference about USPTO's structure.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claim 177 is rejected under 35 U.S.C. § 102(b) as being anticipate by USPTO's MPEP Rev. 14, Nov. 1992.

Claim 177 is directed to a computer-implemented expert matching method for managing communications between an expert and an end user (i.e., a patent examiner's position at USPTO, and an applicant), comprising:

- receiving a first expert qualification (a patent examiner) corresponding to a first expert (i.e., USPTO's specific group director "assigns" an examiner to examine a patent application, said examiner name and his art unit would be given to the applicant for communications relating to examining processes – this examiner name would be communicated to the applicant, and recording to USPTO database/group director as a point-of-contact POC (see USPTO's MPEP Rev. 14, published on Nov. 1992, chapter 700, page 700-5 (section 705.01(e)));
- selecting a second expert that has a second expert qualification, the second expert qualification being higher than the first expert qualification (i.e., a group director/supervisor for this examiner/or a primary examiner outside his art unit for consultation on a specific subject matter e.g., a patent application on business method using a smart-card technology; a primary examiner that specializes in another art unit dealing with smart-card technology is consulted) is also selected to review and approve that examiner's qualification/decision) (see USPTO's MPEP Rev. 14, published on Nov. 1992, chapter 700, page 700-5 (section 705.01(e)) (a group director can transfer an examiner to a different art unit for a better "fit", his personal record is sent to a supervisor of said different art unit for reviews);
- transmitting the first expert qualification to the second expert (e.g., internal "transmitting" via computer communication said examiner's qualification to that group director/supervisor for a best match between examiners to examining a customer's application), (see USPTO's MPEP Rev. 13, published on Nov. 1989, chapter 1005, page 1000-9, this section inherently requires an examiner having Partial-Signatory-Authority to

sign a certain Office Action after he has been authorized to do so (after examiner's qualification is reviewed by a group director)); and

- receiving a signal from the second expert that indicates approval of the first expert qualification (i.e., a supervisor "assigns" a specific patent application to said examiner after reviewing and approval of said examiner's qualification for a claimed specific subject matter – or a group director gives "Partial-Signatory-Authority" to an examiner, (see USPTO's MPEP Rev. 13, published on Nov. 1989, chapter 1005, page 1000-9).

The above claimed limitations are inherently taught in USPTO MPEP Rev. 14, published on Nov. 1992, chapter 700, pp. 700-5 (section 705.01(e)) to 700-8, and USPTO's MPEP Rev. 13, published on Nov. 1989, chapter 1005, page 1000-9).

5. Claims 178-179 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPTO's MPEP Rev. 14, published on Nov. 1992.

A. Claim 178 is directed to a computer implemented expert matching method for managing communications between an expert and an end user, comprising all limitations of claim 177 (analyzed above), and:

- incorporating identity data of the second expert into a key of the first expert.
- The rationales and reference for rejection of claim 177 are incorporated.

USPTO's MPEP teaches that a group director or a supervisor or a primary examiner in a specific art unit (as a second expert) and a patent examiner (as a first expert) are belongs to the same technology center (i.e., the names of a group director/supervisor and his examiners has been required to put together as alternative point-of-contacts in a USPTO Office Action (see USPTO's MPEP Rev. 13, Nov. 1989, chapter 1002.02, page 1000-3 for teaching that identity data (names, art unit, Technology

Center) of a group director and his examiner appears on an Official Document at USPTO; if a consultation about a specific topic was happened, said primary examiner's name has been included in the record for search consultation).

B. Claims 179, and 185 are directed to a computer implemented expert matching method for managing communications between an expert and an end user, comprising all limitations of claim 178, and:

- submitting the first expert qualification for review by a set of experts/(or a second expert) that having a qualification that is higher than the first expert qualification (e.g., personal record of an examiner has been distributed to different supervisor(s) for a better match);
- receiving a signal from the set of experts/(or from a second expert) that indicates approval of the first expert qualification (e.g., a telephone call from a supervisor to a director);
- receiving an end user request from an end user; selecting the first expert based on the end user request (e.g., a request from applicant to exam a case under "special status" because said patent's inventor is 75 year-old; that case has been assigned to a specific examiner);
- transmitting end-user's request to the first expert; receiving an expert answer responsive to the end user request, the expert answer containing information about the second expert (e.g., communication between an examiner and an applicant for a patent application having a second expert's inputs/opinion); and
- transmitting the expert answer to the end user (e.g., mailing an Office Action from USPTO to an applicant).

The above claimed limitations also can be done manually.

6. Claim 180-189 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPTO's MPEP Rev. 14, published on Nov. 1992.

A. As to claims 180-181, 183, 186-187, and 189: The examiner respectfully submits that it is old and well-known that an applicant for a US Patent must make payment to USPTO to begin an examination process – that means a guaranteeing payment to the USPTO - comprises requiring the customer to prepay before considering a service (by checking/verifying an account for validity - for a good balance before charging a fee)..

It would have been obvious to one of ordinary skill in the art at the time of invention to appreciate an old and well-known fact that USPTO financial department could check a customer account to confirm that “everything is fine/conformed” when charging an applicant’s account as required in USPTO’s MPEP before rendering an examination service.

B. As to claims 182, and 188: The examiner respectfully submits that a duty of Office of Finance at USPTO is checking a credit card account (checking an applicant’s deposit account for a fee paid, or for a good balance).

C. Claim 184: The examiner respectfully submits that it is old and well known about establishing a price for the expert answer corresponding to the end user request; and if credit available on the credit card account is less than a required fee, requesting that the end user provide a credit card number of another credit card account (USPTO’s practice).

D. Claim 185: A computer implemented expert matching method for managing communications between an expert and an end user, comprising:

- receiving a first expert qualification corresponding to a first expert;

- selecting a second expert that has a second expert qualification, the second expert qualification being higher than the first expert qualification;
- transmitting the first expert qualification to the second expert;
- receiving a signal from the second expert that indicates approval of the first expert qualification;
- receiving an end user request from an end user; selecting the first expert based on the end user request; transmitting at least a portion of the end user request to the first expert;
- receiving the expert answer responsive to the end user request; the expert answer containing information about the second expert; and
- transmitting the expert answer to the end user.

E. Claim 186: The examiner respectfully submits that it is old and well known about guaranteeing payment to the first expert (a paycheck every 2 weeks).

F. Claim 187: The examiner respectfully submits that it is old and well known about requiring the end user to prepay (an inventor must prepay to exam his invention for USPTO annual budget).

G. Claim 189: The examiner respectfully submits that it is old and well-known about checking a credit card account is performed before said transmitting at least a portion of the end user request to the first expert (USPTO checking a deposit account before ordering an examiner to examine an invention).

7. Referring to the argument on the paper received on 4/09/2001 (page 3, 2nd paragraph), that “...nothing in **USPTO procedure** entails the claimed steps of “receiving a first expert “qualification” corresponding to the first expert”, nor “transmitting the first

expert “qualification” to a second expert”, nor “receiving a “signal” from a second expert that indicates approval of the first expert “qualification”, the examiner submits that these kinds of actions have been widely used in many areas (USPTO might not expressly say that limitation exactly as claimed languages, neither published those ideas, but in its telephone directory, or organization chart, clearly showing a hierarchical order that reflecting above limitations, i.e., art unit 705, sub-class 26 defined the listed examiners having “e-shopping” knowledge/skills to examining this kind of specific cases, the supervisor of this art unit (A.U. 3625) has a senior level of patent examining functions and familiarity with this skill levels; accordingly, she is the right one to give a second opinion about her examiner’s qualification; furthermore, a director (as her boss) has more of this particular skills comparing to an ordinary examiner or a supervisor in these group art units (since most of the director and supervisor have climbed up the ranks from the same arts). Upon making decision about a consulted matter, a “YES” or “NO” answer has been given (this may be in oral, or in writing, or using an e-mail; equivalent to a communicating “signal”). USPTO ‘s method of doing business would be related to “expert qualification” comprising a first expert (examiner) and a second expert having authority to approve the first expert “qualification” (his supervisor). This has widely used/been available in public knowledge; this idea of doing business from USPTO would be implemented in cited references by one of ordinary skills in the art, it comprises hierarchical authorities.

“Practice and procedure in Patent and Trademark Office -- Prosecution -- Rules and rules practice (§ 110.0905) Patent and Trademark Office, during ex parte examination, is not precluded from relying upon hearsay evidence in making rejections,

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since applicants are free to investigate any hearsay assertions relied upon by examiner, have right to introduce rebuttal evidence, and, if they wish to cross-examine authors of written hearsay assertions, can file civil action pursuant to 35 USC 145.”


8. Related Reference: For rejecting claims 177-189, an NPL reference was provided to the applicants on 6/07/2004, titled “Examination of Applications (13 pages from USPTO’s MPEP).

Conclusion

9. Claims **177-189** are not patentable.
10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CUONG H. NGUYEN whose telephone number is 571-272-6759. The examiner can normally be reached on 7:30 am - 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, THOMAS G. BLACK can be reached on 571-272-6956. The Rightfax number for the organization where this application is assigned is 571-273-6759.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


CUONG H. NGUYEN
Primary Examiner
Art Unit 3661